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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,379	09/08/2000	Aaron I. Vinik	05126.00003	4987

7590 03/26/2004

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EXAMINER

ROBINSON, HOPE A

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8/17

Advisory Action

Application No.

09/659,379

Applicant(s)

VINIK ET AL.

Examiner

Hope A. Robinson

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 21 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-49.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

DETAILED ACTION

1. Applicant's response to the Office Action mailed April 21, 2003 on February 2, 2004 is acknowledged.

Claim Disposition

2. Claims 1-49 are pending and under examination.
3. Applicant is reminded of the continuing obligation under 37 CFR 1.56 to timely apprise the Office of any litigation information, or other prior or concurrent proceeding, involving Patent No. 5,804,421, which is material to patentability of the claims under consideration in this reissue application. This obligation rests with each individual associated with the filing and prosecution of this application for reissue. See MPEP 1404, 1442.01 and 1442.04.
4. Applicant's arguments filed February 2, 2004 have been fully considered but are not persuasive.

The rejection under 35 U.S.C. 103, NonStatutory Double Patenting, has been maintained.

5. Claims 1-20 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/717,095 for the reasons of record.

6. Claims 1-49 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 5,840,531 for the reasons of record.

7. Applicant's arguments filed on February 2, 2004 have been fully considered. Pages 2-5 of the response merely state the facts presented in case laws and statutes pertaining to double patenting which have been considered but does not warrant any remarks from the examiner. The Vinik Declaration has been considered, however, was not found to be persuasive as it does not address the issues raised in the rejections of record, it merely state that applicant could not have filed claims directed to the subject matter claimed in application number 741,096 which is one of the parent file for the instant application. The arguments presented on pages 6-15 will be addressed in this office action.

On page 6 of the response applicant state that claims 1-24 of the copending application (09/717,095) and claims 1-17 of U.S. Patent No. 5840531 are cited as rendering the subject claims as obvious. It is also stated that each of claims 1-8, 15-16 and 18-22 of the cited copending application and the cited patent recites a nucleotide sequence encoding a pre-protein of INGAP, i.e., including residues 1-25 of SEQ ID NO:2. Claims 9-14 and 23-24 are said to be directed to probes and DNA molecules, which comprise at least 30 contiguous nucleotide encoding INGAP of SEQ ID NO:2. Claim 17 is stated as directed to an antisense construct which comprises inter alia a nucleotide sequence encoding all or a portion of a protein as shown in SEQ ID NO:2. Applicant further states that claims 1-26 (SEQ ID NO:6) are specifically and explicitly excluded. The issue here remains that the claims in the instant application recite the open language "comprising" in association with the recitation of "residues 27-175", thus,

residues 1-26 are not really excluded as asserted by applicant. The recited sequence in the application has one residue difference with the sequence set forth in the instant copending application. The copending application is directed to an isolated DNA molecule which encodes an INGAP protein set forth in SEQ ID NO: 2 which is identical to SEQ ID NO: 6 of the instant application with the exception of one residue (SEQ ID NO: 6 has an additional Methionine in the beginning of the sequence) and as open language is present the sequences in the applications are obvious. The same situation is present in claims 13-17.

On page 7 Applicant states that claims such as claim 21 recite primers and the patent and copending application recite probes. This argument is not persuasive as it is known in the art that probes and primers are used interchangeably. Probes are used in hybridization and primers in amplification, which are commonly used together. This is also admitted in applicant's statements. On page 7 it is stated that the primers were amplified and that the primers hybridize to the 5' and 3' ends which indicates that primers can be used in both reactions.

At pages 7-15, applicant provides a discussion that involves a break down of *Graham v. John Deere Co.* Applicant's statements have been considered. Again the argument is made that residues 1-26 of SEQ ID NO:2 in the copending application is excluded from SEQ ID NO: 6 of the instant application, which is not factual as the claim recites open language which would include those residues. Additionally, the argument presented about claims directed to probes, primers and anti-sense constructs is not persuasive as the rejection of record sets forth that the two applications although differ in scope are obvious variations of each other, for example, a probe is not specific as such can be obtained from any polynucleotide.

Applicant on pages 12+ state that the rejection is based on a number of misapprehensions reflected in misstatements of fact in the office action. Applicant is reminded that a terminal disclaimer was filed in response to the above rejection now stated to be erroneous, however, the terminal disclaimers were improper. In addition, the office drafted claims, which would not warrant the filing of terminal disclaimers and are deemed allowable which applicant has refused. In view of the foregoing, applicant's statements are not persuasive and thus the rejection remains.

Conclusion

8. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday from 9:00 a.m. to 6:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S.F. Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hope A. Robinson, MS 

Patent Examiner


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